

REMARKS

Applicants have carefully reviewed the Final Office Action mailed January 4, 2011 (hereinafter “Final Office Action”), and respectfully request reconsideration of the subject application, particularly in view of the above amendments and the following remarks.

Information Disclosure Statement Filed October 25, 2010

Applicants filed an Information Disclosure Statement (IDS) in the subject application on October 25, 2010. The Patent Office asserts that the IDS fails to comply with 37 CFR § 1.98(a)(3) “because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each of the 776 documents listed” (Final Office Action, page 2). The Patent Office then indicates that “[i]t has been placed in the application file, but the information referred to therein has not been considered” (*Id.*).

37 CFR § 1.98(a)(3) states:

(3)

(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c). (Emphasis added.)

Pursuant to 37 CFR § 1.98(a)(3)(i), a “concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information” is required only for that information “that is not in the English language.” Applicants note that the vast majority of the references cited in the IDS are in the English language. Applicants further note that an English translation of the abstract has been provided for all references not in the English language. Applicants therefore submit that the IDS is in compliance with 37 CFR § 1.98, and respectfully request that the Examiner consider the

references cited in the IDS, and indicate consideration thereof in the next communication mailed by the Patent Office in the subject application.

Status of the Claims

Claims 26–28, 30–35, 37–41, and 43–45 were previously pending. Claims 1–25, 29, 36, and 42 were previously cancelled. Claims 27, 34, and 41 have been amended herein to correct an inadvertent typographical error. In particular, claim 27 previously inadvertently indicated that the “*second input identifier identifies a second location in a second template*” (emphasis added). The reference to “a second template” was inadvertent, and incorrect, and thus the clause has been amended in claim 27 to properly recite that the “*second input identifier identifies a second location in the first template.*” This amendment makes claim 27 consistent with claim 28, which depends from claim 27, and which recites “*integrating, by the computer, the second data into the first template at the second location to generate the document*” (emphasis added). Claims 34 and 41 have been amended similarly, for identical reasons.

Applicants respectfully request that this amendment be entered because such amendment should not require a new search, since it now merely aligns claim 27 with claim 28, which necessarily would have been searched on the basis of the second location being associated with the first template, rather than a second template. Moreover, this amendment should be entered because such amendment places the subject application in better form for appeal.

No claims have been added or cancelled herein. Accordingly, claims 26–28, 30–35, 37–41, and 43–45 are pending.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 26–28, 30–35, 37–41, and 43–45 were rejected under 35 U.S.C. § 112, second paragraph, as being vague to determine the scope of the subject matter which Applicants regard as the invention. Applicants respectfully traverse.

Applicants submit that claims 26–28, 30–35, 37–41, and 43–45 as a whole apprise one of ordinary skill in the art of their respective scope, and have at least a “reasonable degree of clarity and particularity,” and therefore comport with the second paragraph of 35 U.S.C. § 112 (see MPEP § 2173.02). Applicants further note that the Federal Circuit has held:

The requirement to “distinctly” claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles. *Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1547 (Fed. Cir. 1984). Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004). (Emphasis added.)

The Patent Office first asserts: “As currently claimed, it is not clear whether the portable image capture device is programmed with plurality of template identifiers and input identifier associated with each of the template identifiers.”

The Patent Office thus asserts a lack of clarity regarding whether the portable image capture device is “programmed with [a] plurality of template identifiers.” Applicants submit that claim 26 clearly requires “a first template identifier.” Applicants believe this is not only not “insolubly ambiguous,” but is quite clear. Applicants’ claim 32 depends from and further narrows claim 26, and recites that the first template identifier is selected from “a plurality of template identifiers.” Thus, claim 26 requires a single (one) template identifier, and claim 32 requires more than one template identifier, i.e., “a plurality of template identifiers.” Applicants believe claims 26 and 32 as a whole apprise one of ordinary skill in the art of their respective scope, and have at least a “reasonable degree of clarity and particularity,” and therefore comport with the second paragraph of 35 U.S.C. § 112.

The Patent Office also questions whether “input identifier [is] associated with each of the template identifiers.” Applicants’ claim 26 recites “a first input identifier associated with the first template identifier.” Again, Applicants believe that this requirement is not only not “insolubly ambiguous,” but is quite clear. Applicants’ claim 27 recites “a second input identifier associated with the first template identifier.” Thus, claim 27 further narrows claim 26, and recites that there are two input identifiers associated with the first template identifier, i.e., the first input identifier and the second input identifier. Applicants believe these limitations as a whole apprise one of ordinary skill in the art of their respective scope, and have at least a “reasonable degree of clarity and particularity,” and therefore comport with the second paragraph of 35 U.S.C. § 112. If the typographical error in claims 27, 34, and 41, as discussed above, plays a role in the Patent Office’s assertion that such claims are vague and indefinite (and it is not clear

whether it does or does not), then Applicants submit that this is yet one more reason to enter the amendment discussed above. Clearly, if the typographical error is the basis of the present rejection, the entry of such amendments will place the application in better form for appeal because such amendments will resolve the present rejection.

The Patent Office next asks: “How does the computer know which input identifier is the data associated when input identifier associated with the data is not communicated to the computer along with the first template identifier and the first data to be integrated at the proper location in the first template.”

Applicants note that claim 26 recites: “*communicating the first template identifier and the first data to a computer on which the first template is stored for integration of the first data into the first template.*” In essence, it appears to Applicants that the Patent Office is asserting that Applicants’ failure to recite the precise manner in which the computer knows how to integrate the first data into the first template renders claim 26 vague and indefinite. Applicants respectfully disagree, and note that at the time of the invention, those skilled in the art knew of many ways to correlate data in a communication with a particular purpose. For example, the data may be communicated in a packet with a predetermined format such that the computer accesses the first data at a particular data offset within the packet. Alternately, the data may be preceded with a predetermined tag that indicates that the data following the tag comprises the first data. Applicants submit that there are any number of known ways to correlate data communicated between two devices, and Applicants are not required to claim a particular one of such ways, because Applicants’ recited embodiment is not limited to any particular manner of doing so.

The Patent Office then asks: “How capturing of the second data and storing of the captured second data is associated with the generation of the report at the computer.”

Applicants believe this question is answered by the limitations of claim 28, which recites:

*communicating the first template identifier, the first data, and the second data to the computer;
integrating, by the computer, the first data into the first template at the first location; and
integrating, by the computer, the second data into the first template at the second location to generate the document.*

Thus, in one embodiment, as recited in claim 28, the captured second data is associated with the generation of a document by the integration thereof into the first template at the second location by the computer. Again, Applicants believe that his language is far from “insolubly ambiguous without a discernible meaning,” and, in fact, is quite clear.

For the foregoing reasons, Applicants respectfully request that the rejection under 35 U.S.C. § 112 be withdrawn.

Rejection Under 35 U.S.C. § 103(a) – Ajamian, Wright, and Tsunoda

Claims 26–28, 30–35, 37–41, and 43–45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0064345 A1 to Ajamian et al. (hereinafter “Ajamian”) in view of U.S. Patent No. 5,704,029 to Wright, Jr., et al. (hereinafter “Wright”) and U.S. Patent No. 7,466,347 B2 to Tsunoda (hereinafter “Tsunoda”). Applicants respectfully traverse. When determining whether a claim is obvious, an Examiner must make “a searching comparison of the claimed invention—including all its limitations—with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418, 82 U.S.P.Q.2d (BNA) 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Among other features, Applicants’ claim 26 recites:

selecting, via a portable image capture device, a first template identifier stored in the portable image capture device, wherein the first template identifier identifies a first template that is not stored in the portable image capture device.

The Patent Office refers to Ajamian, Wright, and Tsunoda as disclosing this feature (Final Office Action, pages 5–6). Applicants respectfully disagree that any of the cited references, alone or in combination, teach the use of a first template identifier stored in a portable image capture device that refers to a first template that is not stored in the device.

Ajamian discloses a web-based document repository useful for managing insurance claims (Ajamian, Abstract). The Patent Office refers to Figure 2 of Ajamian. According to

Ajamian, Figure 2 is “a flowchart showing the course or progress of a non-emergency claim or contractor direct claim through the method of the present invention” (Ajamian, paragraph 0024). Paragraphs 0031–0036 of Ajamian describe Figure 2, and disclose, generally, a web site where various documentation associated with analyzing and resolving an insurance claim may be stored. Applicants can find nothing in Ajamian teaching or suggesting the use of a first template identifier stored in a portable image capture device that refers to a first template that is not stored in the device. If the present rejection is maintained on the basis of Ajamian, in an effort to expedite prosecution, Applicants respectfully request the Patent Office to cite with specificity a particular passage or portion of Ajamian where the Patent Office believes this feature is disclosed.

Wright discloses a personal digital assistant (PDA) that may execute a form via a forms engine that runs on the PDA to prompt a user to collect data (Wright, Abstract). Wright fails to disclose the use of template identifiers because Wright discloses to load forms onto the PDA (see, e.g., elements 120–122 of Figure 1 of Wright).

Tsunoda fails to remedy Wright’s and Ajamian’s deficiencies in this regard. Tsunoda discloses a document drafting system wherein a camera contains a template (Tsunoda, Abstract). After taking a photograph, a user of the camera may select the template (Tsunoda, column 6, lines 52–61). The photograph is then pasted into the template (*Id.*).

Accordingly, Applicants submit that none of the cited references, alone or in combination, teaches or suggests the use of a first template identifier stored in a portable image capture device that refers to a first template that is not stored in the device.

Applicants’ claim 26 also recites “*communicating the first template identifier and the first data to a computer on which the first template is stored for integration of the first data into the first template.*”

The Patent Office refers to Ajamian as disclosing this feature (Final Office Action, page 7), and refers to Figure 2 of Ajamian, and the text corresponding thereto. Applicants respectfully disagree that any portion of Ajamian teaches or suggests “*communicating the first template identifier and the first data to a computer on which the first template is stored for integration of the first data into the first template.*” Rather, Ajamian teaches a web site where data, including documents, associated with the management and resolution of an insurance claim may be stored. Applicants can find no disclosure regarding template identifiers, or a template stored on a

computer that is not stored in a portable capture device, as explicitly recited in Applicants' claim 26.

For at least the foregoing reasons, Applicants submit that claim 26 is allowable over the cited references. Claims 33 and 40 contain substantially similar limitations to those discussed above with regard to claim 26, and should therefore be allowable for at least the same reasons.

Claims 27, 28, and 30–32 depend directly or indirectly from claim 26, and should therefore be allowable as depending from an allowable independent claim. Claims 34, 35, and 37–39 depend directly or indirectly from claim 33, and should therefore be allowable as depending from an allowable independent claim. Claims 41 and 43–45 depend directly or indirectly from claim 40, and should therefore be allowable as depending from an allowable independent claim.

Conclusion

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicants' representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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